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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,628	07/28/2003	Tomohisa Sakurai	14357A	4908
23389	7590	09/16/2005		
SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530			EXAMINER FLANAGAN, BEVERLY MEINDL	
			ART UNIT 3739	PAPER NUMBER

DATE MAILED: 09/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/628,628

Applicant(s)

SAKURAI ET AL.

Examiner

Beverly M. Flanagan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 25-39 is/are pending in the application.
- 4a) Of the above claim(s) 25-30 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 31-33 is/are allowed.
- 6) ☒ Claim(s) 34 and 36-39 is/are rejected.
- 7) ☒ Claim(s) 35 is/are objected to.
- 8) ☒ Claim(s) 25-39 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/794,864.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

BEVERLY M. FLANAGAN  
PRIMARY EXAMINER

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/28/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of the invention of Group II (claims 31-39) in the reply filed on July 11, 2005 is acknowledged. Accordingly, claims 25-30 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

### ***Information Disclosure Statement***

The information disclosure statement filed July 28, 2003 has been made of record and the references cited therein have been considered by the examiner.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 34 and 36-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Culp et al. (U.S. Patent No. 6,017,354).

**In regard to claims 34 and 36-39**, Culp et al. show an operation system comprising : a plurality (col. 58, lines 56-63) of handpieces 32 for generating

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predetermined energies (col. 3, lines 44-45); col. 24, lines 37-40; col. 57, lines 53-56); a driving signal generator 36 for generating a driving signal with which said plurality of handpieces is driven; an output switching unit for switching the output destinations of the driving signal to select any of said plurality of handpieces (col. 58, lines 56-63); selection signal generators 39, for generating a selection signal which indicates that any of said plurality of handpieces has been selected (col. 58, lines 56-63), a notifier 814, 816 for notifying information of a handpiece, from which the selection signal is transmitted, out of said plurality of handpieces; and a switching control unit for controlling said switching unit so that the output destinations of the driving signal will be switched to select the handpiece, from which the selection signal is transmitted, from among said plurality of handpieces (col. 58, lines 56-63). Said output switching control unit gives control according to a selection signal induced with a press of a remote control switch 46 so as to switch the output destinations of the driving signal to thus apply the driving signal to a handpiece selected with the selection signal (col. 21, lines 55-58). A touch screen display 37 integral with control console 36 serves as the interface through which information about the handpieces 32, 33 is presented to surgical personnel.

***Allowable Subject Matter***

Claim 35 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 31-33 are allowed.

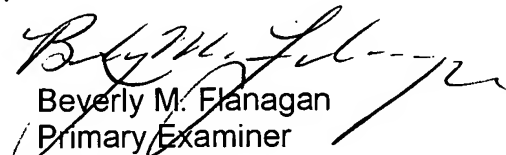
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The following is a statement of reasons for the indication of allowable subject matter: Culp et al. do not teach or fairly suggest a hand-held member and hold detect device for initiating the selection of the proper unit and switching of the proper driving signal energy to the selected unit as set forth in claims 31 and 35. Culp et al. do disclose a switch device 39 in the handpiece 32, but the function of hand switch 39 is to control on/off state and speed of the motor (see col. 7, lines 46-50), and not whether it is being held, as set forth in claims 31 and 35. Mantoba (U.S. Patent No. 6,899,538) teaches a similar multiple handpiece device with identification means, but the identification means lack a hold detect device, as set forth in claims 31 and 35 of the instant invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beverly M. Flanagan whose telephone number is (571) 272-4766. The examiner can normally be reached on Mondays, Tuesdays and Thursdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Beverly M. Flanagan  
Primary Examiner  
Art Unit 3739

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